

*REMARKS/ARGUMENTS**The Present Invention and the Pending Claims*

Claims 1-9 are pending. Claims 1-5 are directed to a method for producing a 5 α -pregnane derivative represented by the formula (III). Claims 6-9 are directed to a method for producing (20S)-7 α ,21-dihydroxy-20-methyl-5 α -pregn-3-one represented by the formula (VII).

Summary of the Claim Amendments

Claims 1 and 6 have been amended to recite that the compound of formula (I) (claim 1) or (V) (claim 6) is selectively hydrogenated with palladium-carbon. This amendment is supported by the specification at, for example, page 14, line 8, through page 15, line 7. No new matter has been added by way of these amendments.

Summary of the Office Action

Claims 1-9 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly not enabled by the specification. Reconsideration of the pending claims is hereby requested.

Discussion of the Enablement Rejection

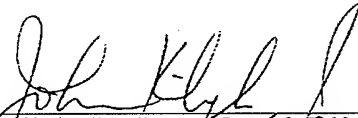
Claims 1-9 allegedly are not enabled by the specification. In particular, the Office contends that the specification enables the use of certain palladium catalysts but does not enable the use of all transition metal complexes as selective hydrogenation catalysts.

To expedite prosecution and not in acquiescence of the rejection, independent claims 1 and 6 have been amended to recite that the compound of formula (I) (claim 1) or (V) (claim 6) is selectively hydrogenated with palladium-carbon. The Office Action indicates that the specification enables "certain palladium catalysts" and specifically mentions palladium-carbon (Pd/C) (see page 4, item 2; page 6, item B; and pages 6-7, item D). Therefore, in view of this amendment, Applicants submit that the enablement rejection of claims 1-9 has been overcome. Applicants respectfully request that this rejection be withdrawn.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



John Kilyk, Jr., Reg. No. 30,763
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6731
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

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